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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,458	12/13/2001	Luis M. Ortiz	O&L 1000-1086	4602
7590 01/23/2007 Kermit D Lopez / Luis M Ortiz Ortiz & Lopez PLLC P O Box 4484 Albuquerque, NM 87196-4484			EXAMINER YODER III, CHRISS S	
			ART UNIT 2622	PAPER NUMBER
			MAIL DATE 01/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/015,458	Applicant(s) ORTIZ ET AL.	
	Examiner Chriss S. Yoder, III	Art Unit 2622	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 1-3,5,7-12,14,16,18-22,24,28-31,70 and 72.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because:

A.

- Applicant argues, with respect to Anderson, that obviousness can not be met because Anderson does not teach the use of a hand held device. However, the Examiner again points out that Anderson teaches a portable device (column 5, lines 34-38) which is well within the range of being a hand held device.

- Applicant also argues, that a user of a head mounted display form factor, would not be able to or interested in the simultaneous viewing of video captured from more than one video source. Having no exemplary or evidentiary support for this statement, the Examiner feels this statement is unfounded.

- Applicant also argues, that Anderson specifically call on Ronzani (US Patent # 5,844,656) for support of a HMD. However, the Examiner notes that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). In this case, the disclosed example of Ronzani does not limit the Anderson device to a specific embodiment, but rather Anderson merely states that this is one example. And therefore, arguments directed toward Ronzani are considered moot.

- Applicant also argues, that the HMD taught by Anderson is worn by or attached to a person's head and does not constitute a hand held device during operation. However, it is noted that the features upon which applicant relies (i.e., being held in the user's hand during operation) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

- Applicant also argues, that Anderson would not support Applicants' teaching because Anderson is technically limited to head mounted form factor, and that Duhault would not benefit from using Anderson's teachings. And based on this, how can the skilled in the art expect to be motivated to combine Duhault with Anderson, because the "skilled in the art" would not be motivated because the combination simply wouldn't work and it wouldn't be desirable for a user to view simultaneous images through binoculars. As for Applicant's statement that the combination wouldn't work and that it wouldn't be desirable, having no exemplary or evidentiary support for this statement, the Examiner feels this statement is unfounded. Additionally, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Duhault teaches that the simultaneous display of more than one video signal is preferred in order to allow the user to monitor multiple programs simultaneously (column 1, lines 26-28).

B.

- With respect to Duhault, Applicant argues that the suggestion to combine fails because Duhault was never "available" to Applicants when they filed their patent application on December 13, 2001. As basis for this argument, Applicant refers to "The Intellectual Property and Communications Omnibus Reform Act of 1999," Pub. L. No. 106-113, 4505, 113 Stat. 1501A-565, 590 (Nov. 29, 1999) (codified at 35 U.S.C. §102(e) (Supp. 2000)), which the Examiner notes is also known as the "American Inventors Protection Act of 1999", (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)), in order to define availability as the effective filing date determined by the requirements for 35 U.S.C. 102(e) under the AIPA.

- However, the Examiner Points out that 35 U.S.C. 102(e) has been further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)).

MPEP § 2136 [R-3] -- 35 U.S.C. 102(e) states as follows:

Revised 35 U.S.C. 102(e), as amended by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)), and as further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)), applies in the examination of all applications, whenever filed, and the reexamination of, or other proceedings to contest, all patents. Thus, the filing date of the application being examined is no longer relevant in determining what version of 35 U.S.C. 102(e) to apply in determining the patentability of that application, or the patent resulting from that application. The revised statutory provisions ~~supersede~~ all previous versions of 35 U.S.C. 102(e) and 374, with only one exception, which is when the potential reference is based on an international application filed prior to November 29, 2000 (discussed further below). The provisions amending 35 U.S.C. 102(e) and 374 in Pub. L. 107-273 are completely retroactive to the effective date of the relevant provisions in the AIPA (November 29, 2000). Revised 35 U.S.C. 102(e) allows the use of certain international application publications and U.S. patent application publications, and certain U.S. patents as prior art under 35 U.S.C. 102(e) as of their respective U.S. filing dates, including certain international filing dates. The prior art date of a reference under 35 U.S.C. 102(e) may be the international filing date if the international filing date was on

or after November 29, 2000, the international application designated the United States, and the international application was published by the World Intellectual Property Organization (WIPO) under the Patent Cooperation Treaty (PCT) Article 21(2) in the English language. See MPEP § 706.02(f)(1) for examination guidelines on the application of 35 U.S.C. 102(e).

And therefore, based on the revised 35 U.S.C. 102(e), as amended by the Intellectual Property and High Technology Technical Amendments Act of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)), the effective 102(e) date of Duhault (US Patent #6,657,654) is considered the filing date of June 29, 1999 (no international filing dates are present).

A handwritten signature in black ink, appearing to read 'Vivek Srivastava', is written over a horizontal line.

VIVEK SRIVASTAVA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600